Supreme Court, U. S.
FILED
JAN 11 1980
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1979

No. 79-1219

R. W. SIMS, Trustee, and
R. W. SIMS, Trust,

Petitioners,

v.

MACK TRUCKS CORP.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

INTRODUCTION.

R. W. Sims, Trustee, and R. W. Sims, Trust, petition for a writ of certiorari to review the judgments and opinions of the United States Court of Appeals for the Third Circuit in its Appeals No. 78-2516 and No. 78-2517.

Appeal No. 78-2516 relates to issues of patent validity and infringement, and Appeal No. 78-2517 refers to allowance of attorneys' fees for a successful plaintiff in exceptional patent cases. These two cases present common legal issues and were decided by the Third Circuit Court of Appeals in one Opinion. We file this single petition to seek review of both judgments in accordance with Rule 23.5 of the Rules of this Court.

OPINIONS BELOW.

The Opinion of the Court of Appeals is unreported, and is reprinted in the Appendix to this petition as Appendix Item A1-A18. The Memorandum of Decision and Order of the District Court for the Eastern District of Pennsylvania is reported at 459 F. Supp. 1198 (E. D. Pa., 1978), and is reprinted as Appendix Item A19 to A42.

JURISDICTION.

The judgment of the Court of Appeals was entered on October 16, 1979. This Petition for a Writ of Certiorari is filed within ninety days of that date. Jurisdiction of this Court is based upon 28 U. S. C. § 1254(1).

QUESTIONS PRESENTED.

Whether a patent may be invalidated as "obvious" by applying nonobjective standards of patentability, where those standards are absent in 35 U. S. C. § 103.

Whether inclusive within the 35 U. S. C. § 103 test for invention, is a new, independent and cumulative requirement, "synergism", which must be met in the case of combination mechanical inventions.

STATEMENT OF THE CASE.

Petitioners, R. W. Sims, Trustee, and R. W. Sims, Trust are the owners of U. S. Patent No. 2,859,949, a copy of which appears in this petition as Appendix Item, pp. A43-A48. The petitioners are a small family trust. Sims is a small entrepreneur in Salt Lake City, Utah, who pioneered the Front Discharge Concrete Mixer Truck, a photograph of which appears as Appendix Item A49.

When this new machine first appeared in the art, in 1963, it evoked wide-spread derision on the part of those

"skilled in the art", because of the radical way in which it broke with the prior art. News of this truck soon reached Mack Trucks. To learn more about the truck, and with a view toward negotiating a patent license, Mack dispatched its chief engineer and vice president, Walter F. May, to Salt Lake City in August, 1963. Sims gave the respondent, Mack Trucks, Inc., access to his facilities where the original prototypes of the patented machine were located (1030A).

After thoroughly evaluating Sims's patented truck, Mack's patent counsel concluded that Sims's patent was valid (1036A), but Mack Engineers felt the advance in the art represented by the invention was too revolutionary, and was such a marked departure from the conventional teachings of the art at that time, that it was both impractical and unworkable (1042A, 1145A, 529A). For instance, top engineers at Mack were skeptical of the invention particularly because of the high discharge point (1048A) extending up and over the cab, and additional problems such as weight distribution, which they regarded as "insurmountable" (1072A).

None of these concerns was expressed to Sims by Mack Trucks, who, instead, elected to decline license agreements with Sims, issuing to him a standard rejecting statement.

Mack's original decision was later considered by them to be a mistake, even though the decision was taken by those skilled in the art, since the invention proved neither "inoperative" nor containing "insolvable problems" (1070A, 1072A).

Sims was not discouraged by Mack's rejection, and his subsequent move was to put inexperienced newcomers, free of the prejudices of the art, into the business within a matter of months, and they quickly proved the patented principle at the marketplace. The machine was an unqualified success. Mack Trucks' response was to review

their mistakes and loss of business with alarm, and, to catch up quickly, Mack dispatched one of its engineers to make a copy of the device as it appeared in Anderson, Indiana, and to cover up the copying. The manager of engineering suggested to the vice president of Mack that they destroy the evidence of copying (1139A). Within a matter of months after Mack's decision to proceed, it started promoting the Front Discharge Concrete Mixer truck that ten years earlier it had rejected as "impractical". Sims attempted to restore negotiations when he learned of Mack's changed decision, but without success.

Sims then brought this action for patent infringement in the United States District Court for the Eastern District of Pennsylvania, April 3, 1975, under 28 U. S. C. § 1400(b).

Although originally only charging Mack with patent infringement, the complaint was later amended to include unfair competition as a result of Mack's having gained access to Sims's trade secrets and confidential information. Jurisdiction was here based upon 28 U. S. C. § 1338(b).

In detailed Findings of Fact and Conclusions of Law following a trial held April 3-7 and reopened July 6-7, 1978, during which infringement was not seriously contested, the District Court found Sims's patent to be valid, infringed, and, because of the deliberate nature of the infringement,[1] increased the damages, under 35 U. S. C. § 284. Judgment was entered September 15, 1978.

In an extensive Opinion, District Court Judge Lord made a thorough and clinical analysis of the patented invention in the manner prescribed by the Supreme Court in *Graham v. John Deere Co.*, 383 U. S. 1 (1966), and he applied the *Deere* analysis as it is interpreted by the Third Circuit in their decisions *Systematic Tool & Machine Co. v. Walter Kidde & Co.*, 555 F. 2d 342 (3d Cir., 1977), and *Universal Athletic Sales Co. v. American Gym, Recreational & Athletic Equipment Corp., Inc.*, 546 F. 2d 530 (3d Cir., 1976). Judge Lord analyzed and determined the issue of patentability under 35 U. S. C. § 103 by addressing three factual inquiries: (a) the scope and content of the prior art, (b) the differences between the prior art and the claims of the patent, and (c) the level of ordinary skill in the pertinent art.

1. On eight different occasions, Mack was advised in written form by its internal general counsel, or its patent counsel retained for the purpose of evaluating patents, or patent counsel associated with the other companies, that what it was doing was either an infringement or inducement of infringement of Sims's patent.

The District Court considered all of the evidence, including certain secondary criteria: the duration of the problem, the slavish copying by Mack, the great skepticism expressed by those at the highest engineering levels of Mack. Judge Lord found this evidence to be more reliable than the hired testimony of one of Mack's customers.

In an Opinion filed October 16, 1979, the United States Court of Appeals for the Third Circuit reversed Judge Lord's holdings of validity, mooting the other patent-related issues in the case, including infringement and attorneys' fees.

The Court of Appeals states, A10, A11:

> "The trial court's position is understandable. The 'art to which said subject matter pertains' and the 'person having ordinary skill' in that art, are hardly precise notions. Indeed, our opinions in Systematic Tool & Machine Co. v. Walter Kidde and Co., 555 F. 2d 342 (3d Cir., c.d. 434 US 857 (1977), and Universal Athletic Sales Co. v. American Gym Recreational and Athletic Equipment Corp., 546 F. 2d 530 (3d Cir., 1976), c.d. 430 U. S. 984 (1977), reflect the difficulty the courts have had with the third *Graham* test."

After recognizing that the District Court attempted to comply with language of the Supreme Court opinions in *Sakraida v. AgPro, Inc.*, 425 U. S. 273 (1976) and *Anderson's Black Rock v. Pavement Salvage Co.*, 369 U. S. 57 (1969) in finding as a fact that a "synergistic" effect resulted from the combination of elements in the patented truck, the Court of Appeals proceeded to hold the patent invalid without holding the District Court was clearly erroneous in finding as a fact that the invention exhibited "synergism", or that the art generally at the highest skill levels viewed the invention as "impractical", and were skeptical of its operability at the time of the invention. All such findings must be taken as fully accurate. Rule 52(a), Federal Rules of Civil Procedure.

The Court of Appeals also vacated and remanded Count II of the Unfair Competition claim (Appeal No. 78-2518), which was joined with the patent Count I under 28 U. S. C. 1338(b), on the grounds that it was error for the District Court to dismiss Count II on a Motion for Summary Judgment. No review by this Court of the holding of the Court of Appeals in Appeal No. 78-2518 is sought by the petitioners.

1. REASONS FOR GRANTING THE WRIT AS TO THE FIRST QUESTION.

The history of the patent statute makes it clear that more is required to sustain a valid patent than that it be merely "new". *Hotchkiss v. Greenwood*, 52 U. S. 248 (1850). This historical development of the requirement for greater substance to an invention than mere "newness", was eventually codified in 35 U. S. C. § 103.

There is a confusion in the circuits over the effect of recent decisions of this court on *Graham v. John Deere (supra)* tests of obviousness, first articulated in 1966. This case is exemplary of the confusion. Guidance by this Court is urgently needed if the constitutional mandate for the patent system is to achieve its ends to: "promote the Progress of Science and the useful Arts". Art. 1, § 8, cl. 8, Constitution of the United States.

Congress enacted 35 U. S. C. § 103 in 1952. Fourteen years later, this court, in *Graham v. John Deere (supra)* undertook an authoritative interpretation of 35 U. S. C. § 103, holding that the criteria in a determination of patent validity must become evident from an orderly series of inquiries, in the following language, 383 U. S. 1, 14:

> "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved."

This appeal involves the third factual inquiry, namely, the resolution of the level of ordinary skill in the pertinent art. But how is the relevant art defined? By what talisman does one recognize the person of ordinary skill in the art? Here is where courts rely on expert testimony for guidance, and here is where the qualifications of the expert are so critical.

Judge Lord, in "adopting the standard of a designer of self-transit concrete mixers", declined to give weight to the testimony of one of defendant's "experts", who was not a designer in the relevant art, who never tested the patented construction, who never purchased one, who could not even comprehend the advantages of the system, and who had no perception even of the problems of the art, much less the solutions. Appendix Item, pp. A50, A52. Yet, this was held to be reversible error. Is there any wonder why there is confusion over 35 U. S. C. § 103?

There is a still further question: Can a Court of Appeals adopt a new standard of invention by "viewing the question of validity from the eyes of Sakraida", and then go on to substitute its own notion of ordinary skill in the pertinent art, unaided by relevant testimony and without finding the District Court to be clearly erroneous? By reaching its conclusions solely on the basis of a subjective hunch gathered from treatment of other inventions in other Supreme Court decisions, namely, *Sakraida v. AgPro (supra)* and *Anderson's Black Rock (supra)*, is the Court carrying out the mandate of objective analysis of inventions described as follows in *Deere*, 383 U. S. 1, 14:

> "We believe that strict observance of the requirements laid down here will result in that uniformity and definiteness which Congress called for in the 1952 Act."

The Unintended Effect of Blackrock and Sakraida on Deere's Objective Standards of Patentability.

The Third Circuit Court of Appeals' decisions reflect the confusion found throughout all of the circuits in the manner in which the courts are applying and following recent Supreme Court decisions and their modifying effect, if any, on *Graham v. John Deere (supra)* and 35 U. S. C. § 103. Some courts declare that there has not been any change. *Republic Industries, Inc. v. Schlage Lock Co.*, 592 F. 2d 963 (7th Cir., 1979). Other courts ascribe to these decisions a new standard of patentability. *Herschensohn v. Hoffman*, 592 F. 2d 893 (9th Cir., 1979), cert. den. 203 USPQ 720 (1979).

The Third Circuit, equivocating on that issue, has rendered a series of decisions which are confused and contradictory from decision to decision, within this economically important circuit. Initially, in *Universal Athletic Sales Co. v. American Gym Recreational and Athletic Equipment Corp. (supra)*, the Third Circuit adhered to the *Deere* analysis, requiring that the standard of invention be set at the level of ordinary skill in the pertinent art, and the Court mandated that witnesses be competent and demonstrate their credentials in the pertinent art at the time the invention was made. From that vantage point, the witness could then declare what was expected from the ordinarily skilled in the pertinent art and at the time the invention was made.

Universal Athletic Sales Co. v. American Gym Recreational and Athletic Equipment Corp. (supra) case was decided after *Anderson's Black Rock v. Pavement Salvage Co. (supra)*, and this Court refused a Petition for Writ of Certiorari No. 76-1233, cert. den. 197 USPQ 783 (1978). Less than a year later, the Third Circuit took an about-face in *Systematic Tool Machine Co. v. Walter Kidde & Co. (supra):* the Third Circuit interpreted the "level of ordinary skill in the pertinent art" to be adducible through a person having no recognizable knowledge of the relevant art, but having demonstrated just general skills sufficient to give invalidating testimony, apparently attempting to comply with recent Supreme Court decisions.

It is not necessary to emphasize the irreconcilability of these two Third Circuit decisions, or the confusion

which the Third Circuit Court is experiencing in correctly interpreting the Supreme Court decisions. The Third Circuit expressed candidly its confused holdings, stating, A10, A11:

> "The trial court's position is understandable. The 'art to which the said subject matter pertains' and the 'person having ordinary skill' in that art are hardly precise notions. Indeed, our opinions in *Systematic Tool & Machine Co. v. Walter Kidde & Co.*, 555 F. 2d 342 (3d Cir.), cert. denied, 434 U. S. 857 (1977), and *Universal Athletic Sales Co. v. American Gym, Recreational & Athletic Equipment Corp.*, 546 F. 2d 530 (3d Cir., 1976), cert. denied, 430 U. S. 984 (1977) reflect the difficulty that courts have had with the third *Graham* test."

The statutory intent of 35 U. S. C. § 103 was to impart a sense of objectivity into the standard of "obviousness". This Court's decision in *Sakraida v. AgPro (supra)* is now being cited by the Third Circuit and other circuits as a return to the subjective views in which each court is called upon to psyche itself into a view of the barn-cleaning invention of Sakraida and then, in that frame of mind, asks itself, "How should we view the invention before us?" That is not the contemplated operation of 35 U. S. C. § 103, and it is not the intent of *Sakraida v. AgPro (supra)* to return the patent law to judicial "hunches" cut loose from the objective standards of 35 U. S. C. § 103. It is up to this court to mandate a return to a disciplined (admittedly more difficult) intellectual approach, to what is "obvious".

The Third Circuit Court illustrates the problem as it concluded its review of Judge Lord's Opinion with this language, Appendix pp. 11, 12:

> "Looking at this record through Sakraida's eyes leads us to conclude that the Willard patent was obvious to a mechanic familiar with the design of concrete mixers as well as to a reasonable man. We therefore hold that the application of the Graham criteria compels a finding of obviousness."

In the trilogy of patent cases decided concurrently by this Court in 1966, the 35 U. S. C. § 103 tests laid down in *Deere* were also applied in *Calmar v. Cook Chemical*, 383 U. S. 1 (1966) and in *U. S. v. Adams*, 383 U. S. 39 (1966). In *Adams*, the patent was held valid in a factual setting similar to the one at bar. Yet, perhaps because it has been over a decade since this Court has last held a patent valid, the lower courts have focused on *Sakraida* and have ignored *Adams* as if it were overruled.

Before World War II, Adams worked in his home on the development of a water-activated battery, and after successfully developing the battery, he promptly filed a patent application on his invention. He brought the battery to the attention of the Army and Navy, and was rebuffed by leading scientists at the Army Signal Corps and the National Bureau of Standards who expressed doubts about the workability of his battery. Pressure of the war effort, however, eventually caused the Government to take another look at the Adams battery in 1943, and by 1956, after years of successful use, the Government lauded the advantages of the Adams water-activated battery. Adams was never notified by the Government as to its changed attitude about his battery, or about its use of his battery, until 1950 when his claim for compensation was denied.

After finding that the prior art did not anticipate the Adams battery, the Court stated, 383 U. S. 39, 47:

> "We conclude the Adams battery was also non-obvious. As we have seen, the operating character-

istics of the Adams battery have been shown to have been unexpected and to have far surpassed then-existing batteries. Despite the fact that each of the elements of the Adams battery was well-known in the prior art, to combine them as did Adams required that a person reasonably skilled in the prior art must ignore . . . (certain factors). These long-accepted factors, when taken together, would, we believe, deter any investigation into such a combination as is used by Adams. * * * *

Nor are these the only factors bearing on the question of obviousness. *We have seen that at the time Adams perfected his invention noted experts expressed disbelief in it.* Several of these same experts subsequently recognized the significance of the Adams invention, some even patenting improvements on the same system." (emphasis added).

The question is: Is *Adams* still good law? If it is, the lower courts should be instructed to consider all the relevant evidence bearing on patentability, including the so-called secondary considerations and the *ante litem motem* views of experts. If it is no longer good law, this Court should clearly so instruct the circuits.

Had the Third Circuit Court judges looked at all the evidence, they would have seen a record almost identical with that of *Adams (supra).* The experts from Mack and the art generally, just as in *Adams,* at the time of his invention, not only deemed the invention "unobvious", but declared that it was so different in form, function and result that it was "impractical" (1041A, 1048A, 1145A). The Mack engineers in 1963 (1048A) listed four different reasons why Sims's device could never "work": (a) drum shape, (b) drum height, (c) weight distribution, (d) drum position. But the circuit judges now say these are

"obvious" and taught by the prior art.[2] Mack believed the new design was fraught with difficulties of such magnitude that Mack did not even want to become involved! Mack's engineering reports, discovered during the course of the litigation, tell eloquently that this invention, far from being obvious to those of ordinary skill, was viewed by those of the highest skill in the art with great skepticism to the extent that they predicted failure. It was only because of the endurance of Sims, who had grit enough to go ahead despite conventional wisdom, that the invention was successful.

The fact that Mack made an exact copy of the invention and urged the report to be destroyed (1139A) is also compelling secondary evidence ignored by the Circuit Court.

The fact that Mack was advised in eight different legal opinions by its own and other patent counsel, was ignored by the Third Circuit Court.

Altogether, Mack was advised directly or indirectly by (a) its internal general counsel, D. S. Bowie; (b) its patent counsel which is retained for the purpose of evaluating patents (Brumbaugh, Graves, Donohue & Raymond), and (c) patent counsel associated with other companies (Rexnord), that what it was doing and proposing to do was (i) an infringement; (ii) an inducement to infringe, or (iii) a contributory infringement of the patent in suit, 1036A (Gardner, of Brumbaugh, Graves, Donohue & Raymond); 1067A (Rexnord); 1102A (Brumbaugh, of Brumbaugh, Graves, Donohue & Raymond); 1121A (Bowie, general counsel for Mack Trucks); 1108A (Granville Brumbaugh, of Brumbaugh, Graves, Donohue & Ray-

2. The allegedly anticipative prior art used by the circuit judges was referenced in Sims' patent as illustrations of problems overcome by the patented principle. A45. Thus, the Patent Office's view of the invention was also swept aside and the "problem" art was held anticipative!

mond); 1415A (Byron T. Gardner, Brumbaugh, Graves, Donohue & Raymond); 1029A (Bowie, general counsel, Mack Trucks); 1106A (Bowie, general counsel, Brumbaugh, Graves, Donohue & Raymond).

The fact is that Sims's weak financial condition was used by Mack as a reason for proceeding. But that, also was ignored.

2. REASONS FOR GRANTING THE WRIT AS TO THE SECOND QUESTION.

The decision of the Third Circuit concerns a widespread expression of the problem of dealing with patentability. Standards have become confused and divisive among the circuits.

Although the statutory test for patentability makes no reference to "synergism", this has become commonly accepted as a new requirement for patentability among several circuits, but by no means all. Some circuits declare there is a new and added requirement for patentability in addition to the statutory requirement as well as the requirements elucidated in *Graham v. John Deere.* This new position is taken in these circuits: *Parker v. Motorola,* 524 F. 2d 518 (5th Cir., 1975); *Phillips Industries, Inc. v. State Stove Mfg. Co.,* 522 F. 2d 1137 (6th Cir., 1975); *Reinke Mfg., Inc. v. Sidney Mfg. Corp.,* 201 USPQ 345 (8th Cir., 1979); *Deere & Co. v. Heston Corp.,* 201 USPQ 721 (9th Cir., 1979); *Satco, Inc. v. Transequip, Inc.,* 594 F. 2d 1318 (9th Cir., 1979), c.d. 48 USLW 3013 (79-50, July 24, 1979), *Plastic Container Corp. v. Continental Plastics of Oklahoma, Inc.,* 203 USPQ 27 (10th Cir., 1979). But the contrary view is held in *Republic Industries, Inc. v. Schlage Lock Co. (supra).*

Every mechanical invention must consist of old parts and elements. Just as the universe is made up of a finite number of elements, so the mechanical arts are made up of a finite and fixed number of components: screws, bolts, levers, cams, gears, wheels, etc. This is to be expected and, indeed, progress of science and the useful arts depends on these parts being assembled in different ways to achieve new and extraordinary results. *U. S. v. Adams (supra).* Thermodynamically, it would be impossible for these to add up to a result greater than their individual

contributions, but they can function and interrelate together in different ways to produce new and different results. This is the sense of the recent Supreme Court decisions, not the hunt for an esoteric, hidden meaning which relieves the courts from following the more difficult but intellectually demanding analysis of *Deere*. Invalidating patents on formulistic grounds without considering any of the other criteria of invention as appears under either "primary" or "secondary" evidence, or of adhering to the statutory test, is always the tempting, easy way out.

It is time to put the patentability tests back on the track by elucidating for the lower courts the meaning of this Court's recent decisions.

The Economic Interests of Small Inventors and Entrepreneurs Must Be Protected Through the Patent System.

It has long been the tradition of the Supreme Court, to assist the friendless and protect the weak. Those compelling factors apply today when the private entrepreneur and the individual inventor are abandoning the patent system in droves. 1285A. This case presents the ideal fact situation for the Court to reaffirm the position of the individual inventor who, after having made an invention proclaimed by the industry to be revolutionary, later finds the United States courts engaging in hindsight analyses. It was not within the genius of Mack Trucks to develop this invention; they followed the route of the copyist. Likewise, it is not within the genius of the Circuit Court judges to fly in the face of those who were actually in the art, were baffled by its problems, scoffed at the invention, and who are now, in the brilliance of hindsight, to say that an invention was obvious.

Two things prompted Mack to challenge the patent:

(1) Sims was deemed by Mack on the basis of their research to be a paltry, unfunded threat (1188A), "on the ropes", financially, as they so colorfully put it.

(2) The patent had only two years to run, so the downside risk was minimal (1245A).

The contempt of large corporate infringers for small patentees like Sims, is typically what the record shows. The small inventor needs some protection; if not from the courts, then from where?

It would be simpler but deeply unfair, to consign small inventors to second class privilege. Unfair still is to cause small inventors to rely on patents subject to ambiguous, formulistic, all-encompassing language effective, to break those patents. It would be better for this Supreme Court to deem all future mechanical patents to be unworthy of patenting so that conscientious patent lawyers as well as the Patent Office could deny this area as worthy of issuing patents. This would much better serve the cause of inventors and the small entrepreneurs who would otherwise look to the patent system for protection against their rapacious competitors.

If *U. S. v. Adams (supra)*, the companion case to *Graham*, is no longer the law of the land, small inventors and entrepreneurs such as Sims, should be able to look to this Court for a clear statement to that effect.

This case is the appropriate vehicle to make known this Court's authoritative interpretations of 35 U. S. C. § 103.

CONCLUSION.

For these reasons, a Writ of Certiorari should issue to review the judgment and opinion of the Third Circuit Court of Appeals.

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